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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
BOARD OF PATENT APPEALS AND INTERFERENCES**

**APPLICANT(S):** HONG, Jun-II

**GROUP ART UNIT:** 2173

**APPLICATION NO.:** 10/038,312

**EXAMINER:** ZHOU, Ting

**FILING DATE:** November 9, 2001

**DOCKET:** 678-625 (P9633)

**For: METHOD OF PROVIDING USER INTERFACE IN A PORTABLE  
TERMINAL**

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**APPELLANT'S REPLY BRIEF**

In response to the Examiner's Answer mailed April 18, 2007<sup>1</sup>, Appellant respectfully submits that based on at least the arguments provided in the Second Amended Appeal Brief of December 28, 2006, Claims 1-5 are patentable over the applied references. The following comments are respectfully submitted in order to address statements made in the Examiner's Answer.

The Examiner raises no new grounds for rejection in the Examiner's Answer.

The allegations raised in the Examiner's Answer do not change the fact that Claims 1-5 are patentable over the combination of Pinard and Horwitz.

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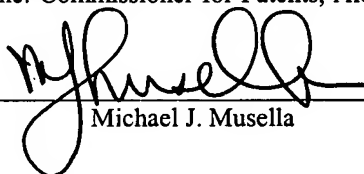
<sup>1</sup> It is noted that the "Mail Date" on the Office Communication page is listed as April 19, 2007, but the stamp on the cover page of the Examiner's Answer states that the Examiner's Answer was mailed on April 18, 2007. This error is duly noted.

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**CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8 (a)**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postpaid in an envelope, addressed to the: Commissioner for Patents, Alexandria, VA 22313-1450, Mail Stop Appeal Brief-Patents on June 14, 2007.

Dated: June 14, 2007

  
Michael J. Musella

### 1. The invention as claimed in the present application

Throughout prosecution, Appellants have maintained that the mere form change of an icon taught by Pinard and in combination with the single function icon of Horwitz is not and cannot be equated with the invoking a plurality of functions by changing the function of a state indicator as recited in the claims of the present application.

The state indicators of the present invention are unique images used to display information about an operation state. Some examples of state indicators include an RSSI (Received Signal Strength Indicator), alarm setting, arrival of an SMS (Short Message Service) message, a battery state, and call reservation setting.

The function change is based the occurrence of a change in the operation state. The change in the operation state is a state change. This change in the operation state, or state change, is not to be confused with a function change.

The function change is a two-step process. First, one of a plurality of functions is registering with the state indicator. Registration of a function is a process that associates a functional task operation module with a state indicator. Second, the state representation of the state indicator is changing. A state representation is the operation state that is associated with a state indicator.

The registered function is invoked upon receipt of a user input directed to the state indicator.

### 2. The combination of Pinard and Horwitz discloses a cursor whose form changes but whose function remains fixed

Pinard in its abstract discloses an animated cursor that changes form. Horwitz discloses a computerized program checking system for organizations, where a flashing icon is displayed upon receipt of an alarm, and the alarm can be responded to upon “double clicking” the icon. A particular, preset and non-changeable function (responding to the alarm) is associated with the displayed icon. Therefore, the combination of Pinard and Horwitz results in an icon that changes form but whose function remains unchanged.

The Examiner would like this honorable Board to believe that Pinard teaches that form and function are the same, even though Pinard contradicts this position. Pinard in its abstract teaches that its invention is a method of indicating (by a change in form) the occurrence of a function that can be implemented on the terminal. Pinard recites in its abstract:

A method of indicating to a user of a terminal which includes a display, of the occurrence of a function which can be implemented on the terminal, comprising displaying a cursor on the display which cursor is moveable by the user and which has a form and position on the display which is related to a program currently being used by the user and which is unrelated to the function, and changing the form of the moveable cursor at the position to one which relates to the function upon occurrence of the function.

Pinard's abstract clearly illustrates that its cursor continues to function as a cursor, although its form changes to relate to an occurrence of a function, and does not actually alter the function of the cursor itself. Horwitz's icon that has a fixed function does not cure Pinard's defect.

### 3. Appellants have properly attacked the combination of Pinard and Horwitz

Finally, the Examiner misapplies the law that one cannot show nonobviousness by attacking references individually where a rejection is based on a combination of references, as held by the Court of Claims and Patent Appeals in *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981), and by the Federal Circuit in *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Throughout Appellants' Appeal Brief, the combination of references is clearly attacked as not disclosing the claimed invention.<sup>2</sup> Appellants respectfully reassert that the combination of Pinard and Horwitz results in an icon that changes form but whose function remains unchanged.

### 4. Conclusion

As the Examiner has failed to make out a prima facie case for an obviousness rejection, the rejection of Claims 1-5 must be reversed.

It is well settled that in order for a rejection under 35 U.S.C. §103(a) to be appropriate, the claimed invention must be shown to be obvious in view of the prior art as a whole. A claim may be

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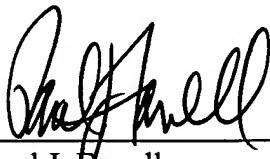
<sup>2</sup> See Second Amended Appeal Brief filed December 28, 2006, at section 1A, pages 6-7, "...Pinard discloses...Horwitz displays... Since neither Pinard nor Horwitz, nor any combination thereof..."; at section 1B, page 7, "...Pinard merely...Horwitz displays... Since neither Pinard nor Horwitz, nor any combination thereof..."; at section 1C, page 8, "...Horwitz discloses ...Pinard merely ... Since neither Pinard nor Horwitz, nor any combination thereof..."; at section 2A, pages 9-10, "...Pinard discloses...Horwitz displays... Since neither Pinard nor Horwitz, nor any combination thereof..."; at section 2B, page 10, "...Pinard discloses...Horwitz displays... Since neither Pinard nor Horwitz, nor any combination thereof..."; at section 3A, pages 11-12, "...Pinard discloses...Horwitz displays... Since neither Pinard nor Horwitz, nor any combination thereof..."; and, at section

found to be obvious if it is first shown that all of the recitations of a claim are taught in the prior art or are suggested by the prior art. In re Royka, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (C.C.P.A. 1974), cited in M.P.E.P. §2143.03.

The Examiner has failed to show that all of the recitations of Claims 1-5 are taught or suggested by the either Pinard or Horwitz or the combination thereof. Accordingly, the Examiner has failed to make out a prima facie case for an obviousness rejection.

Independent Claims 1-5 are not rendered unpatentable by either Pinard or Horwitz or the combination thereof. Therefore, the rejection of Claims 1-5 must be reversed.

Dated: June 14, 2007

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